

REMARKS

Claims 1, 16, 22, 26, and 30-32 are amended; new claims 43-52 are added; and claims 33-42 are canceled, without prejudice or disclaimer. Claims 1-32 and 43-52 are pending.

It is respectfully submitted that forty-two claims were filed and are pending in the present application. Although the office action alleges that the pending claims were numbered 1-40, the present application was filed with forty-two claims numbered 1-42. Enclosed are copies of the filing receipt as well as the Claims Worksheet (Form PTO-2022) in the Image File Wrapper of the present application which clearly indicate forty-two claims and which are consistent with the application as filed.

It is respectfully submitted that page 59 of the application as filed (copy enclosed), which included the bulk of the text of claim 33 and both claims 34-35 in their entirety, was not scanned when the Image File Wrapper of the present application as well as the published application number US 2002/0188863 A1, which corresponds to the present application, were generated.

Accordingly, to rectify the discrepancy in the numbering of the claims of the present application, claims 33-42 have been canceled, without prejudice or disclaimer, and new claims 43-52 are added which mirror claims 33-42 as originally filed, with new independent claims 43 and 47 incorporating amendments comparable or identical to the current amendments to independent claims 1, 16, 22, 26, and 30-32.

The amendments to the claims and new claims 43-52 are based on the application as originally filed. For example, the claims have been amended to recite that the operations with the PAD are performed in real-time to process a user profile and interactive commands, as described in paragraph 57, page 16, lines 3-25; paragraph 59, page 17, lines 8-18; and paragraphs 69-70, page 20, lines 4-24, with the page and line numbers referring to the application as originally filed. Therefore, it is respectfully submitted that no new matter has been added.

In the office action, claims 1-40 (sic) were rejected under 35 U.S.C. § 102(b) in view of U.S. Patent Number US 6,275,824 B1 to O'Flaherty et al.

Independent claims 1, 16, 22, 26, and 30-32 have been amended, and new claims 43-52 are added, with claims 43 and 47 being independent claims, and claims 44-46 and 48-52 depending from claims 43 and 47, respectively. Claims 33-42 are canceled, without prejudice or disclaimer.

Referring initially to amended claim 1, it is respectfully submitted that the present invention is patentable over O'Flaherty, since O'Flaherty does not disclose or suggest all of the elements and features of amended claim 1. In particular, O'Flaherty does not disclose or suggest a personal access device (PAD) contained in a portable housing and associated with a subscriber to the claimed system, with the PAD storing a profile of the subscriber and generating interactive commands transmitted wirelessly; and a privacy service provider (PSP) connected to the wide area network, with the PAD being directly accessible by the PSP under first conditions set by the profile and the PSP being responsive in real-time to the interactive and wirelessly transmitted commands from the PAD, as in amended claim 1.

O'Flaherty describes a system and method for managing data privacy in a database management system. In one embodiment, O'Flaherty describes a client interface module 122 which allows a client to access, control, and manage data using the Internet, a modem, a telephone, or a kiosk using a smartcard or a loyalty card (column 4, line 61 to column 5, line 28).

Claim 1, as amended, is patentable over O'Flaherty, since O'Flaherty does not have a personal access device (PAD) which is contained in a manually portable housing and which generates interactive commands transmitted wirelessly. On the contrary, O'Flaherty teaches away from the present invention, since O'Flaherty teaches the use of smartcards or loyalty cards for use with kiosks, point-of-sale (POS) terminals, or ATMs. Kiosks and POS terminals are not manually portable, as is the PAD of amended claim 1. In addition, smartcards and loyalty cards are manually portable, but there is no disclosure or suggestion in O'Flaherty that such smartcards or loyalty cards are capable of generating and wirelessly transmitting interactive commands to a privacy service provider (PSP), as is the PAD of amended claim 1.

Furthermore, O'Flaherty does not have a PAD directly accessible by the PSP, as in claim 1, since O'Flaherty uses proxy service requests via the Internet, the modem, the kiosk, the POS terminal, or the ATM, as described in column 14, lines 8-30. Although O'Flaherty has smartcards and loyalty cards directly accessible at a kiosk, POS terminal, or ATM, as described above, there is no disclosure or suggestion in O'Flaherty that such smartcards or loyalty cards are themselves capable of generating and wirelessly transmitting interactive commands to a privacy service provider (PSP), as is the PAD of amended claim 1.

In addition, O'Flaherty does not have a PSP responsive in real-time to such interactive and wirelessly transmitted commands from a PAD as in amended claim 1, since O'Flaherty does not have a PAD or PSP which are directly interactive using wirelessly transmitted commands, and since O'Flaherty uses dataviews in one embodiment which are provided to requesting entities in advance (column 14, lines 1-3), as opposed to real-time interaction and approval via wireless commands using a PAD as in claim 1. In another embodiment, O'Flaherty uses dataviews which are provided to a requesting entity indirectly from a database in response to a data request (column 14, lines 3-7), as opposed to directly from the user using a PAD, as in the claimed invention.

Accordingly, one having ordinary skill in the art would not look to O'Flaherty for the elements and features of amended claim 1, so claim 1 is patentable over O'Flaherty.

Independent claims 16, 22, 26, and 30-32 have been amended, and new claims 43 and 47 are added, with the amendments and language of claims 16, 22, 26, 30-32, 43, and 47, respectively, being comparable and/or identical to the amendments of claim 1.

Therefore, for the reasons set forth above for amended claim 1, independent claims 16, 22, 26, 30-32, 43, and 47 are also patentable over O'Flaherty.

Claims 2-15, 17-21, 23-25, 27-29, 44-46, and 48-52 depend from independent claims 1, 16, 22, 26, 30-32, 43, and 47, respectively, and so each of claims 2-15, 17-21, 23-25, 27-29, 44-46, and 48-52 includes the recitation of independent claims 1, 16, 22, 26, 30-32, 43, and 47, respectively. Since independent claims 1, 16, 22, 26, 30-32, 43, and 47 are patentable over O'Flaherty, claims 2-15, 17-21, 23-25, 27-29, 44-46, and 48-52 are also patentable over O'Flaherty.

Therefore, all pending claims 1-32 and 43-52 are allowable over O'Flaherty, so reconsideration and withdrawal of the rejection of claims 1-32, and favorable consideration of new claims 43-52 are respectfully requested.

Accordingly, entry and approval of the present amendment and allowance of all pending claims are respectfully requested.

In case of any deficiencies in fees by submission of the present amendment, the Commissioner is hereby authorized to charge such deficiencies in fees to Deposit Account Number 01-0035.

Respectfully submitted,



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Date: June 21, 2005

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CLAIMS ONLY

SERIAL NO.

09854307

FILING DATE

05-11-01

APPLICANT(S)

CLAIMS

| | AS FILED | | AFTER 1st AMENDMENT | | AFTER 2nd AMENDMENT | |
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* MAY BE USED FOR ADDITIONAL CLAIMS OR ADMENDMENTS



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| APPLICATION NUMBER | FILING DATE | GRP ART UNIT | FIL FEE REC'D | ATTY. DOCKET NO | DRAWINGS | TOT CLAIMS | IND CLAIMS |
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| 09/854,307 | 05/11/2001 | 2131 | 793 | 204,896 | 16 | 42 | 9 |

CONFIRMATION NO. 7818

FILING RECEIPT



OC00000006287988

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Date Mailed: 07/12/2001

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Applicant(s)

Solomon Friedman, Brooklyn, NY;

Domestic Priority data as claimed by applicant

Foreign Applications

If Required, Foreign Filing License Granted 07/11/2001

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Early Publication Request: No

** SMALL ENTITY **

Title

System, method and apparatus for establishing privacy in internet transactions and communications

Preliminary Class

713

Data entry by : SARWARI, HOMA

Team : OIPE

Date: 07/12/2001



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communication;

a plurality of private XML subscriber data files accessible to said PSP, each file being associated with a respective subscriber;

a subscriber programmable personal access device (PAD) for each subscriber to access the respective file and communicate with said PSP; and

a plurality of registered vendors (RVs) linked to the Internet for communication with the subscribers under conditions set by the respective files through said PSP.

34. The system of claim 33, wherein said PSP comprises:

means for receiving communications from a subscriber;

means for transmitting a subscriber's file to that subscriber and for changing data in the subscriber's file in response to the subscriber's authorization;
and

means for communicating with an RV in connection with a subscriber's file.

35. The system of claim 33, wherein each XML subscriber data file includes at least one of the following:

subscriber identifying data;

subscriber credit account data;

subscriber cash account data;

subscriber product preference identifiers; and

subscriber product exclusion identifiers.